APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,816	11/01/2001	Thomas Joshua Shafron	85804-014301	1236

32361 7590 11/08/2006	EXAMINER
GREENBERG TRAURIG, LLP	ROSWELL, MICHAEL

ART UNIT	PAPER NUMBER
2173	

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DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/015,816	SHAFRON ET AL.
	Examiner	Art Unit	
	Michael Roswell	2173	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>22 August 2006</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-24, 59 and 60</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-24, 59 and 60</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14, 16-21, 23, 24, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0077978 A1 (O'Leary et al) and further in view of U.S. Patent Application Publication No. 2002/00623342 A1 (Sidles), and Wiens et al (US Patent 5,808,894), hereinafter Wiens.

Referring to claims 1 and 18, O'Leary discloses in paragraphs 18-33 a method and system for facilitating on-line shopping at a supported merchant web site, the shopper having a computer with an Internet browser installed thereon. O'Leary further discloses in paragraphs 138 and 139 the step of communicating code to add a shopping assistant button to a toolbar of the Internet browser. O'Leary next discloses in paragraph 52 that a wallet is created for the shopper in a database on a server. In paragraph 80, O'Leary explains that the wallet is secured by a first security key (password) previously received from the shopper. O'Leary further explains in this section that each time the user attempts to access the wallet, he or she must enter a user ID and password (second security key) to properly authenticate the user. Upon authentication, O'Leary discloses in paragraphs 80 and 81 that the wallet is communicated to the user's computer. O'Leary, however, fails to explicitly teach communicating computer code for determining if a merchant web site is a supported merchant web site. Sidles discloses in paragraphs 55-58 a method and system for automatically filling out a checkout web page of a

supported merchant. In paragraphs 61-64, Sidles teaches a supported merchant rules and mapping file that is used to perform said filling out. Paragraph 79 discloses associating a verified secure web address with a known form, and automatically filling in the form based on pre-set rules. Sidles explains in paragraph 17 that his invention is advantageous because it "enables users to fill in data forms quickly and efficiently", "eliminates the necessity of manually · establishing a directory of merchant forms", and "can fill forms from both known sites and completely new sites." Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Sidles' supported merchant rules and mapping file in combination with the invention of O'Leary for at least the advantages identified by Sidles.

O'Leary and Sidles both fail to explicitly teach communicating determination code to the user's computer for determining if a merchant web site is a supported web site. Wiens teaches a method for automated ordering by a customer at a remote location to a vendor, similar to that of O'Leary and Sidles. Furthermore, Wiens teaches communicating computer code to a user's computer from the remote vendor, the code containing pertinent vendor information, at col. 7, lines 28-47. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of O'Leary, Sidles, and Wiens before him at the time the invention was made to modify the facilitated on-line shopping system of O'Leary and Sidles to include communicating the determination code of Sidles to the user via the communication system of Wiens. One would have been motivated to make such a combination for the advantage of a user being able to access pertinent information regarding a vendor of interest without being communicatively connected to the vendor, at col. 6, line 66 through col. 7, line 12.

Referring to claims 2 and 20, O'Leary discloses in paragraph 53 that the wallet "performs all of the conventional (e.g., form filling) functions of a traditional wallet". O'Leary further

explains in paragraphs 55 and 56 that the wallet stores "Form filling information such as credit card numbers, debit card numbers, shipping addresses, alternate shipping addresses, frequent flyer accounts, membership discounts (e.g., AAA, AARP), loyalty programs and e-mail addresses", and using this information the wallet "automatically fills in electronic merchant purchase forms with the user's shipping address, e-mail address, discount numbers, etc.". O'Leary, though, fails to specifically disclose utilizing a supported merchant rules and mapping file. Sidles, however, discloses in paragraphs 55-58 a method and system for automatically filling out a check-out web page of a supported merchant and further discloses in paragraphs 61-64 a supported merchant rules and mapping file that is used to perform said filling out. Sidles explains in paragraph 17 that his invention is advantageous because it "enables users to fill in data forms quickly and efficiently", "eliminates the necessity of manually establishing a directory of merchant forms", and "can fill forms from both known sites and completely new sites." Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Sidles' supported merchant rules and mapping file in combination with the invention of O'Leary for at least the advantages identified by Sidles.

Referring to claim 3, O'Leary discloses in paragraph 55 that the shopping assistant comprises a pull-down menu. While O'Leary fails to explicitly teach the shopping assistant button comprising a pull-down menu, the combination of a toolbar button and a pull-down menu is notoriously well-known in the art, and often found in a wide range of applications, from word processors to e-mail clients to web browsers. The Examiner takes OFFICIAL NOTICE of these teachings. Therefore, it would have been obvious to one of ordinary skill in the art to combine the downloaded button of O'Leary to include the pull-down menus taught by O'Leary, for the advantage of a compact interface and ease of use.

Referring to claim 4, O'Leary discloses in paragraph 139 that a web page is communicated to the Internet browser, the shopper enters shopper data on the web page, and the shopper data is stored as a wallet in the database on the server.

Referring to claim 5, O'Leary fails to disclose monitoring the Internet navigation of the Internet browser by intercepting an Internet address for each Internet site to which the Internet browser is caused to navigate. Sidles, however, discloses in paragraphs 53 and 54 a method for intercepting the address to which an Internet browser is caused to navigate. Sidles does this while providing automatic fill in capabilities. According to paragraph 17, Sidles invention advantageously "preserves the privacy of the individual user by keeping personal information, credit card information, and the like safe and under the control of the user or the user's trusted service provider." Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to intercept the address to which an Internet browser is caused to navigate as taught by Sidles in combination with the teachings of O'Leary for at least the advantages identified by Sidles.

Referring to claim 6, O'Leary fails to specifically disclose utilizing a supported merchant rules and mapping file. Sidles, however, discloses in paragraphs 55-58 a method and system for automatically filling out a check-out web page of a supported merchant and further discloses in paragraphs 61-64 a supported merchant rules and mapping file that is used to perform said filling out. Sidles explains in paragraph 17 that his invention is advantageous because it "enables users to fill in data forms quickly and efficiently", "eliminates the necessity of manually establishing a directory of merchant forms", and "can fill forms from both known sites and

completely new sites." Accordingly, it would have been obvious to one of ordinary skill in the art
at the time the invention was made to use Sidles' supported merchant rules and mapping file in
combination with the invention of O'Leary for at least the advantages identified by Sidles.

Referring to claim 7, Sidles teaches communicating a supported merchant data file at
paragraph 79, in the form of a dictionary database used to associate rules and forms with web
addresses.

Referring to claim 8, Sidles discloses in paragraph 64 comparing the supported
merchant data file with an Internet address for each Internet site to which the Internet browser is
caused to navigate.

Referring to claim 9, O'Leary discloses in paragraph 52 that the user can launch the
wallet interface by selecting a wallet icon at the merchant's web site. The wallet icon thus
indicates that the merchant is supported.

Referring to claim 10, O'Leary fails to disclose intercepting each web page received by
the browser and determining the type of web page by HTML code and http request headers
provided in the intercepted web page. As discussed above, to the examiner's knowledge web
pages do not comprise http request headers and the specification has not provided any
teachings to the contrary. It is certainly plausible, though, that the type of a web page could be
determined by the HTML code provided in the intercepted web page. Sidles discloses in
paragraphs 55-58 a method for intercepting a web page and determining its type based on
HTML code. This is an inherent step in automatic form filling. Sidles' system must at the very

least determine whether or not the intercepted web page comprises fields for profile data or

non-profile data as detailed in paragraph 58. It thus would have been obvious to one of ordinary

skill in the art at the time the invention was made to intercept a web page and determine its type

based on HTML code as taught by Sidles in combination with the teachings of O'Leary because

doing so advantageously allows a form filling system to properly identify the appropriate data

fields and fill them accordingly.

Referring to claim 11, O'Leary fails to disclose communicating a secure cookie to the

computer. Sidles, however, discloses in paragraphs 95-99 a method for communicating secure

cookies to a user's computer so that the user need not provide a user name and password each

time a form on a secure page is to be automatically filled. Accordingly, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to communicate a

secure cookie to the user's computer as taught by Sidles in combination with the teachings of

O'Leary so that the user need not provide a user name and password each time a form on a

secure page is to be automatically filled as taught by Sidles.

Referring to claim 19, O'Leary discloses in paragraph 54 that the user's login to the

server is secure and encrypted to protect the confidentiality of financial information.

Referring to claim 59, Sidles teaches a merchant data file comprising supported

merchant rules and mapping information, at paragraphs 61-64.

Referring to claim 60, O'Leary discloses in paragraphs 18-33 a method and system for

facilitating on-line shopping at a supported merchant web site, the shopper having a computer

with an Internet browser installed thereon. O'Leary further discloses in paragraphs 138 and 139

the step of communicating code to add a shopping assistant button to a toolbar of the Internet

browser. O'Leary next discloses in paragraph 52 that a wallet is created for the shopper in a

database on a server. In paragraph 80, O'Leary explains that the wallet is secured by a first

security key (password) previously received from the shopper. O'Leary further explains in this

section that each time the user attempts to access the wallet, he or she must enter a user ID

and password (second security key) to properly authenticate the user. Upon authentication,

O'Leary discloses in paragraphs 80 and 81 that the wallet is communicated to the user's

computer. O'Leary, however, fails to explicitly teach communicating computer code for

determining if a merchant web site is a supported merchant web site. Sidles discloses in

paragraphs 55-58 a method and system for automatically filling out a checkout web page of a

supported merchant. In paragraphs 61-64, Sidles teaches a supported merchant rules and

mapping file that is used to perform said filling out. Paragraph 79 discloses associating a

verified secure web address with a known form, and automatically filling in the form based on

pre-set rules. Sidles explains in paragraph 17 that his invention is advantageous because it

"enables users to fill in data forms quickly and efficiently", "eliminates the necessity of manually

establishing a directory of merchant forms", and "can fill forms from both known sites and

completely new sites." Accordingly, it would have been obvious to one of ordinary skill in the art

at the time the invention was made to use Sidles' supported merchant rules and mapping file in

combination with the invention of O'Leary for at least the advantages identified by Sidles.

O'Leary discloses in paragraph 52 that the user can launch the wallet interface by selecting a

wallet icon at the merchant's web site. The wallet icon thus indicates that the merchant is

supported.

O'Leary and Sidles both fail to explicitly teach communicating determination code to the user's computer for determining if a merchant web site is a supported web site. Wiens teaches a method for automated ordering by a customer at a remote location to a vendor, similar to that of O'Leary and Sidles. Furthermore, Wiens teaches communicating computer code to a user's computer from the remote vendor, the code containing pertinent vendor information, at col. 7, lines 28-47. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of O'Leary, Sidles, and Wiens before him at the time the invention was made to modify the facilitated on-line shopping system of O'Leary and Sidles to include communicating the determination code of Sidles to the user via the communication system of Wiens. One would have been motivated to make such a combination for the advantage of a user being able to access pertinent information regarding a vendor of interest without being communicatively connected to the vendor, at col. 6, line 66 through col. 7, line 12.

Referring to claims 12 and 21, O'Leary discloses in paragraphs 138 and 139 an Internet browser interface displayable by an Internet browser on a computer display comprising a toolbar and a shopping assistant button in said toolbar and defined by computer code operable with a processor of the computer. O'Leary further teaches that the "wallet" for assisting the user in shopping may be downloaded at a content web site and have a button integrated into the browser, at paragraph 52. O'Leary discloses in paragraph 53 that the wallet (shopping assistant) "performs all of the conventional (e.g., form filling) functions of a traditional wallet". O'Leary further explains in paragraphs 55 and 56 that the wallet stores "Form filling information such as credit card numbers, debit card numbers, shipping addresses, alternate shipping addresses, frequent flyer accounts, membership discounts (e.g., AAA, AARP), loyalty programs and e-mail addresses", and using this information the wallet "automatically fills in electronic

merchant purchase forms with the user's shipping address, e-mail address, discount numbers, etc.". O'Leary, though, fails to specifically disclose intercepting an Internet address for each Internet site to which the Internet browser is caused to navigate, determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site, and if the web site is a supported merchant web site, performing the automatic filling using a supported merchant rules and mapping file. Sidles, however, discloses in paragraphs 53 and 54 a method for intercepting the address to which an Internet browser is caused to navigate. Sidles does this while providing automatic fill in capabilities. Sidles further discloses in paragraph 64 the step of determining if a web site is a supported merchant web site. Finally, Sidles discloses in paragraphs 55-58 and 61-64 a method and system for automatically filling out a checkout web page of a supported merchant using a supported merchant rules and mapping file. According to paragraph 17, Sidles invention advantageously "preserves the privacy of the individual user by keeping personal information, credit card information, and the like safe and under the control of the user or the user's trusted service provider." Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to intercept the address to which an Internet browser is caused to navigate as taught by Sidles in combination with the teachings of O'Leary for at least the advantages identified by Sidles.

O'Leary and Sidles fail to teach the determination of a supported merchant web site being done at the user's computer. Wiens teaches a method for automated ordering by a customer at a remote location to a vendor, similar to that of O'Leary and Sidles. Furthermore, Wiens teaches communicating computer code to a user's computer from the remote vendor, the code containing pertinent vendor information, at col. 7, lines 28-47. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of O'Leary, Sidles, and Wiens before him at the time the invention was made to modify the facilitated on-line shopping

system of O'Leary and Sidles to include communicating the determination code of Sidles to the user via the communication system of Wiens. One would have been motivated to make such a combination for the advantage of a user being able to access pertinent information regarding a vendor of interest without being communicatively connected to the vendor, at col. 6, line 66 through col. 7, line 12.

Referring to claims 13 and 24, Sidles discloses in paragraph 64 comparing the supported merchant data file with an Internet address for each Internet site to which the Internet browser is caused to navigate.

Referring to claim 14, O'Leary discloses in paragraph 55 that the shopping assistant comprises a pull-down menu.

Referring to claims 16 and 23, O'Leary discloses in paragraph 52 that the user can launch the wallet interface by selecting a wallet icon at the merchant's web site. The wallet icon thus indicates that the merchant is supported.

Referring to claim 17, O'Leary fails to disclose intercepting each web page received by the browser and determining the type of web page by HTML code and http request headers provided in the intercepted web page. As discussed above, to the examiner's knowledge web pages do not comprise http request headers and the specification has not provided any teachings to the contrary. It is certainly plausible, though, that the type of a web page could be determined by the HTML code provided in the intercepted web page. Sidles discloses in paragraphs 55-58 a method for intercepting a web page and determining its type based on

HTML code. This is an inherent step in automatic form filling. Sidles' system must at the very least determine whether or not the intercepted web page comprises fields for profile data or non-profile data as detailed in paragraph 58. It thus would have been obvious to one of ordinary skill in the art at the time the invention was made to intercept a web page and determine its type based on HTML code as taught by Sidles in combination with the teachings of O'Leary because doing so advantageously allows a form filling system to properly identify the appropriate data fields and fill them accordingly.

Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Leary, Sidles, and Wiens, as applied to claims 12 and 21 above, and further in view of "Band Objects" (Microsoft).

Referring to claims 15 and 22, O'Leary discloses adding a shopping assistant to a toolbar in an Internet browser interface as discussed above, but neither O'Leary nor Sidles discloses adding a toolbar to the Internet browser interface. The "Band Objects" reference supplied on sheet 7 of Applicant's IDS filed 20 February 2004 discloses means for adding toolbars to an Internet browser interface. Microsoft explains in this reference that Explorer Bands contain information or supply tools that are helpful to the user while using the browser. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a new toolbar as taught by Microsoft in combination with the shopping assistant teachings of O'Leary and Sidles. Doing so would have been advantageous because it would have guaranteed a place in the browser interface for the shopping assistant if one had not already existed.

Response to Arguments

Applicant's arguments filed 22 August 2006 have been fully considered but they are not persuasive.

In response to applicant's argument of pages 3-5 of the remarks that Wiens fails to teach communicating determination code to a user's computer for determining if a merchant website is a supported website, the examiner respectfully disagrees. Wiens has been shown to teach the providing of computer code to a user's computer to facilitate offline order entry. Applicant argues that no determination code is contemplated, "since it is explicit in Wiens that the customer knows the vendor that it intends to connect to by virtue of having already completed much of the order entry task prior to establishing a communication session with the vendor computer". However, the examiner contends that this statement serves to underscore the determination computer code taught by Wiens, as the code downloaded by the user in col. 7, lines 28-47 ensures that the central computer connected to by the user is indeed supported. The examiner further contends that while Wiens teaches the offline completion of an order, the fact that the order is transferred through client/server communication makes such a transaction an online transaction. Furthermore, the examiner has relied upon Wiens to teach the communication of determination code from a vendor's server to a client's computer. A combination of Wiens, O'Leary and Sidles would modify the vendor websites of O'Leary and Sidles to include the determination code of Wiens to ensure that the client always has the "pertinent vendor information", and thus that the vendor is indeed a supported one, and therefore that a vendor website is a supported website.

In response to applicant's argument that the Wiens would teach away from a combination with O'Leary and Sidles, the examiner respectfully disagrees. Applicant argues that, "no determination of a supported merchant need be made since the user already knows

which vendor it intends to connect to". The examiner contends that nowhere in the claims is it
required that the merchant in question be previously unknown to the user, and maintains that
the transfer of "pertinent vendor information" teaches the communication of determination code
to a user's computer.

In response to applicant's arguments of claim 60, the examiner apologizes for the
exclusion of the Wiens citation in the previous Office Action, as was the original intention due to
the similar subject matter of claims 1, 18, and 60. Furthermore, the examiner contends that
O'Leary has been shown to teach "wherein said shopping assistant button further provides an
indicator when the Internet browser is caused to navigate to a supported merchant website", as
O'Leary discloses in paragraph 52 that the user can launch the wallet interface by selecting a
wallet icon at the merchant's website. This icon is displayed at the merchant's website, in
contrast to the wallet button on the browser toolbar, and further serves to allow the user quick
access to the related services disclosed in O'Leary, as well as notifying the user that the
website is "supported" in that the user may utilize the available wallet services through the
activation of the displayed wallet icon.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as
set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
MONTHS of the mailing date of this final action and the advisory action is not mailed until after
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Roswell whose telephone number is (571) 272-4055. The examiner can normally be reached on 8:30 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Roswell
11/3/2006

TADESSE HAILU
Patent Examiner